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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,881	04/16/2004	Thomas S. Scanlan	TRUC-0016/2003-214-2	8599

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EXAMINER

DAVIS, BRIAN J

ART UNIT	PAPER NUMBER
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1621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/825,881	Applicant(s) SCANLAN ET AL.	
	Examiner Brian J. Davis	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 23-45 and 48-58 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-13, 59 and 60 is/are allowed.
- 6) ☒ Claim(s) 14-22, 46 and 47 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

The examiner notes for completeness of the record that newly added claims 59 and 60 are encompassed by Group I, the group previously elected for prosecution.

Claim Objections Withdrawn

The objection to claims 14 and 18, outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment corrects the claim text as appropriate.

Claim Objections, NEW

Claim 1 is objected to because of the following informalities: the claim contains an extraneous period mid text (at the end of the paragraph added by applicant's amendment). Claims must begin with a capital letter and end with a period. MPEP 608.01(m). Appropriate correction is required.

102 Rejections Withdrawn

The rejection of claims 1-22, 46 and 47, in so far as they read on the species defined in the previous Office Action, under 35 USC 102(b), has been overcome by applicant's amendment. The amendment narrows independent claim 1 such that the rejection is no longer tenable.

Allowable Subject Matter

The elected species remains free of the prior art. Applicant having overcome by previous rejection, the search was therefore expanded as called for under current Office Markush practice – a compound-by-compound search. This resulted in all species defined by formula I of claim 1 being searched and deemed free of the prior art. The subject matter of claims 1-13, 59 and 60 is therefore allowable (as would any method of use drawn to these compounds).

The search was, therefore, again expanded to include a single additional compound. This compound is defined when, in formula II of claim 14:

$R_1=R_2=R_4=R_5=R_6=R_7=H$; $R_8=OR$ where R is benzyl; $X=$ -lower alkyl O-; $Y=Z= -[C(R)_2]_n-$ where $R=H$ and $n=1$. A rejection follows.

Claim Rejections - 35 USC § 102, NEW

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 14-22, 46 and 47, in so far as they read on the species defined above, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *Annals of Surgery* (1965), 162(4), p. 690-699, discussion p. 699-701 (CAPLUS abstract). The reference teaches applicant's compounds, for instance: RN=7298-53-5.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 **BRIAN DAVIS**
PRIMARY EXAMINER

Brian J. Davis
January 4, 2007